

REMARKS

Claims 1-12 are pending in this application. Claims 1-4 are withdrawn from consideration as being drawn to a non-elected invention. By this Amendment, claims 5-10 are amended and claims 11 and 12 are added. No new matter is added.

I. Allowable Subject Matter

Applicants appreciate the indication of allowable subject matter in claims 6-8 and 10, they being allowable if rewritten in independent form to include all of the features of the base claim and any intervening claims. Applicants submit that the pending claims are allowable for at least the reasons discussed below.

II. Withdrawn Claims

Applicants submit that claim 11 is generic to all pending claims and all Groups of claims, as set forth in the July 29, 2003, Restriction Requirement. Applicants request withdrawn claims 1-4 be rejoined and fully examined for patentability.

III. Claim Objections

Claim 5 is objected to due to a minor informality. Claim 5 is amended in reply to the objection. Thus, Applicants respectfully request the objection of claim 5 be withdrawn.

IV. Claim Rejections Under 35 U.S.C. §103

Claim 5 is rejected under 35 U.S.C. §103(a) as anticipated by U.S. Patent Application Publication No. 2001/0041586, published on November 15, 2001 to Irube et al. (Irube). The rejection is respectfully traversed.

Applicants assert that Irube does not disclose or suggest each and every feature recited in amended claim 5. For example, Irube does not disclose or suggest a camera capable of communicating with another communication device, comprising *inter alia*, an announcing device to announce an incoming call that comes from another communication device, to a camera used in a plurality of announcing manners including at least a vibration announcing

manner, ... a detecting device to detect a state of the camera which is related to photographing, and a prohibiting device to prohibit at least a vibration announcing among the plurality of announcing manners for the incoming call responsive to the state of the camera detected by the detecting device.

Rather, Irube merely discloses "Handy-type" terminals which may announce an incoming call in various ways. However, Irube is silent regarding prohibiting such announcement of calls depending on the state of the camera detected by the detecting device.

Regarding the feature of "a plurality of announcing manners," although the Office Action alleges that it would have been obvious to one of ordinary skill to provide "the plurality of announcing manners on a single phone, and to enable the user to switch the announcing manner to the preferred method of announcing incoming calls, which reads on the switching of the state of the camera", the Office Action provides no support for such a statement.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the invention was made" is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references (MPEP §2143.01). In this case, the Examiner fails to provide any supportive reference for the claim that one of ordinary skill would provide the features as set forth in the Office Action. Additionally, even were such a reference provided, the Office Action fails to provide some objective reason to combine the teachings. The notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (MPEP §2144.03). Thus, Applicants submit that Irube does not disclose or suggest each and every feature recited in the rejected claim, nor does the Office Action provide a *prima facie* case of obviousness.

Accordingly, Applicants respectfully request the rejection of claim 5 under 35 U.S.C. §103(a) be withdrawn.

V. The Claim Rejections Under 35 U.S.C. §102

Claim 9 is rejected under 35 U.S.C. §102(b) as anticipated by Japanese Patent No. 408265716A to Fukasaka. The rejection is respectfully traversed.

Applicants respectfully request that before any further consideration of Fukuoka, the Patent Office should provide a full translation of this Japanese reference. See Ex Parte Gavin, 62 USPQ2d 1680, Board of Patent Appeals and Interferences, December 17, 2001.

Applicants assert that Fukasaka does not disclose a camera capable of communicating with another communication device, comprising *inter alia*, a preventing device to prevent shooting with the imaging device while the announcing device is announcing the incoming call.

As understood from the Abstract of Fukuoka, the system detects an incoming call, and for detecting whether the camera is being used as a pictorial art camera, or as a portrait camera, at the time of the incoming call. The system also provides a switch 19c for switching the using state from the portrait camera to the pictorial camera when a call is being received. Accordingly, Applicants submit that Fukuoka does not disclose or suggest all of the features recited in the rejected claim. Accordingly, Applicants request the rejection of claim 9 under 35 U.S.C. §102(b) be withdrawn.

VI. New Claims

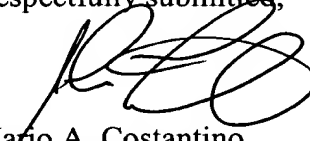
Applicants assert that claims 11 and 12 are allowable for at least the reasons discussed above regarding claims 5 and 9. Furthermore, Applicants submit that none of the applied references of record, whether considered alone or in combination, disclose or suggest the additional features recited in claims 11 and 12.

VII. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-10 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



Mario A. Costantino
Registration No. 33,565

John W. Fitzpatrick
Registration No. 41,018

MAC:JWF/ldg

Date: January 28, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
